

## **II. REMARKS/ARGUMENTS**

### ***Claim Status of Parent Application***

In the parent application, claims 1-39 are pending. Claims 1, 6, 10, 15, and 30 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the enablement requirement. Claims 1, 2, 5, 10, 11, 34 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Agrawal, R. Gupta, A. Sarawagi, S: Modeling Multidimensional databases, IBM Almaden Res. Center, San Jose, CA, USP, 7-11, April 1997, pages 232-43, hereinafter “Agrawal” in view of U.S. Patent No. 6,226,647 to Venkatasubramanian et al., hereinafter “Venkatasubramanian.” Claims 3, 4, 12, 13, and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Agrawal in view of Venkatasubramanian and further in view of U.S. Patent No. 6,438,537 to Netz et al., hereinafter “Netz’537.” Claims 6, 9, 35, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,366,905 to Netz et al., hereinafter “Netz’905” in view of Venkatasubramanian. Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Netz’905 in view Venkatasubramanian and further in view of Netz’537. Claims 15-19, 30-33, and 37-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Netz’537 in view of Venkatasubramanian. Claims 20, 22-23, and 25-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable of Netz’537. Claims 21, 24, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Netz’537 in view of Netz’905.

### ***The 112 Rejections of Parent Case***

Claims 1, 10, 15, and 30 stand rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the enablement requirement. Specifically, the examiner refers to the claim limitation “without the query specifying any calculated members of the database.”

The examiner, however, has not met the burden of making an enablement-based rejection. The examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). MPEP 2164.04. The minimum requirement is the for the examiner

to give reasons for the uncertainty of the enablement. *In re Bowen*, 492 F.2d 859, 862-3, 181 USPQ 48, 51 (CCPA 1974). MPEP 2164.04. Specific technical reasons are always required. MPEP 2164.04. In the office action, the examiner has merely pointed to the limitation at issue, but has not provided *any* reason, technical or non-technical, as to the uncertainty of the enablement.

In any event, the application as originally filed enables claims 1, 10, 15, and 30, which recite “without the query specifying any calculated members of the database.” The background section of the application describes conventional OLAP systems which require that a calculated member be explicitly requested by a query (application p. 2, ll. 26-28). One aspect of the invention provides a technique for accessing calculated members of a database without the query specifying the calculated members. For example, in one embodiment, the extension “AddCalculatedMembers” is included in a query to direct the data processing system to include calculated members (application p. 11, ll. 1-30). More specifically, in the same embodiment, the data processing system determines a hierarchical context based on an input data set (application p. 9, ll. 13-20, and p. 10, ll. 9-13). Thereafter, the data processing system determines if any calculated members exist within the hierarchical context (application p. 13, ll. 16-26). Specific examples are then shown in the Figures and exemplary results are shown in Table 4 (application p. 12). As such, given the description of the prior art and the description of the relationship between the exemplary query extension “AddCalculatedMembers” and the hierarchical context, the application clearly enables one of skill in the art to make and use the invention without undue experimentation.

***Relation of Present Continuation Application to Netz’905 and Netz’537***

***(Claim Rejections Under 35 U.S.C. §§ 102(e) /103 – Netz’905 and Netz’537 of Parent Case)***

In the parent application, claims 3, 4, 6-9, 12-33, 35, and 37-39 each stand rejected using one of either Netz’905 or Netz’537. Netz’905 and Netz’537, however, are commonly owned with the present invention by Microsoft Corporation and are asserted as prior art under 35 U.S.C. § 102(e). As will be explained below, this preliminary amendment is being submitted with a

continuation application to overcome the § 102(e)/103(a) rejections of claims 3, 4, 6-9, 12-33, 35, and 37-39.

The new rule changes to 35 U.S.C. § 103(c) under the American Inventors Protection Act of 1999 render moot the obviousness rejections of claims 3, 4, 6-9, 12-33, 35, and 37-39 under 35 U.S.C. § 102(e). Section 4807 of the Act amended § 103(c) to read as follows:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, ***shall not preclude patentability*** under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. (emphasis added).

“The mere filing of a continuing application on after November, 29, 1999, with the required evidence of common ownership, will serve to exclude commonly owned 102(e) prior art that was applied, or could have been applied, in a rejection under 103 in the parent application.” MPEP 706.02(l)(1). The present continuing application is filed herewith, and thus after November 29, 1999. Therefore, the above-cited changes in the law to § 103(c) are applicable to the present application.

#### *Statement of Common Ownership*

Both the present application and Netz’905 are commonly owned and assigned to Microsoft Corporation. Both the present application and Netz’537 are commonly owned and assigned to Microsoft Corporation. Further, the present invention and Netz’905 were either assigned to Microsoft Corporation or subject to an obligation of assignment to Microsoft Corporation at the time the present invention was made. The present invention and Netz’537 were either assigned to Microsoft Corporation or subject to an obligation of assignment to Microsoft Corporation at the time the present invention was made. The assignment documents for Netz’905 can be found at reel/frame reel: 010202, frame: 0546, recorded: 8/25/99 and the assignment documents for Netz’537 can be found at reel: 010202, frame: 0598, recorded: 8/30/99. The assignment document for the present patent application is attached hereto.

In view of the filing of the present continuation application after the November 29, 1999 effective date of the American Inventors Protection Act of 1999, applicant submits that the rejections of claims 3, 4, 6-9, 12-33, 35, and 37-39 under 35 U.S.C. § 103(a), each of which rely on either Netz'905 or Netz'537, should be withdrawn because both Netz'905 and Netz'537 and the present application were commonly owned at the time of filing. In the absence of Netz'905 and Netz'537 as a reference, the rejection under § 103 must fail. Accordingly, applicant respectfully requests reconsideration and withdrawal of the rejections of claims 3, 4, 6-9, 12-33, 35, and 37-39 under 35 U.S.C. § 103(a).

***The 103(a) Rejections in the Parent Case***

***Independent Claims 1 and 10***

Independent claims 1 and 10 include features that are neither disclosed nor suggested by the cited references, either taken alone or in combination, namely as represented by claim 1 which recites “*processing the query using any calculated members of the database that is within at least one of the subsets of the database, without the query specifying any calculated members of the database.*” (emphasis added)

The invention as claimed in claims 1 and 10 is directed to processing a query to a multidimensional database, and more particularly, to processing the query using both non-calculated and calculated members of the database, if desired. Conventional database queries do not return calculated members unless they are explicitly requested (application as originally filed at page 2, lines 26-28) *i.e.*, the user must know about and specify the calculated member. The invention provides a technique to access calculated members *without requiring detailed knowledge of the database* (application as originally filed at page 2, line 30 to page 3, line 2) and therefore, *without specifying the calculated member itself*. Moreover, the technique may return calculated members that are within a subset of members of an input data set. In this manner, returned calculated members may be more likely to be relevant.

Agrawal does not disclose or suggest processing a query using non-calculated members specified by the query and calculated members, *without the query specifying any calculated*

*members of the database*, as recited by the claims. The examiner seems to concede that Agrawal does not disclose or suggest processing a query using non-calculated members specified by the query and calculated members, *without the query specifying any calculated members of the database* (office action, p. 4, ll. 5-8). The examiner then relies on Venkatasubramanian for allegedly disclosing processing a query using calculated members with a query that does not specify any calculated members of a database, citing to Venkatasubramanian at c. 2, ll. 15-27. Just six lines later, however, Venkatasubramanian notes that SQL statements (or queries) request data records that include *specified* dimension values and measure values (c. 2, ll. 32-34). Therefore, Venkatasubramanian simply uses conventional SQL queries and does not disclose or suggest the recited features. Further, the examiner equates a set of records with non-calculated members and equates records with calculated members. Applicant submits that this an erroneous reading of Venkatasubramanian. Applicant submits that the records referred to in Venkatasubramanian are data in the database and that the set of records referred to is an output data set that results from a query.

Therefore, the cited references, either taken alone or in combination, do not disclose or suggest “*processing the query using any calculated members of the database that is within at least one of the subsets of the database, without the query specifying any calculated members of the database,*” as recited by the claims. (emphasis added)

Accordingly, applicant submits that the cited references, either taken alone or in combination, do not disclose or suggest all the features of independent claims 1 and 10. Additionally, inasmuch as dependent claims 2, 5, 11, 34, and 36 (which have also been rejected) are dependent on claims 1 or 10, these claims are patentable, at least by virtue of their dependency. Therefore, applicant respectfully requests reconsideration and withdrawal of the rejections of claims 1, 2, 5, 10, 11, 34, and 36 under 35 U.S.C. § 103(a).

### ***Conclusion***

For all the foregoing reasons, applicant respectfully submits that the present application is now in condition for allowance. Reconsideration and an early Notice of Allowance are

**DOCKET NO.:** MSFT-2738/138343.2

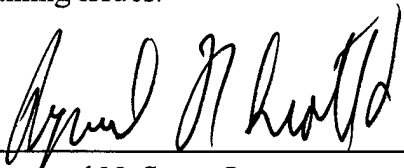
**PATENT**

**Application No.:** Not Yet Assigned

**Office Action Dated:** Preliminary Amendment – First Action Not Yet Received

respectfully requested. In the event that the examiner cannot allow the present application for any reason, the examiner is encouraged to contact the undersigned attorney, Raymond N. Scott Jr. at (215) 564-8951, to discuss resolution of any remaining issues.

Date: July 23, 2003

  
\_\_\_\_\_  
Raymond N. Scott, Jr.  
Attorney for Applicant  
Registration No. 48,666

Woodcock Washburn LLP  
One Liberty Place - 46th Floor  
Philadelphia PA 19103  
Telephone: (215) 568-3100  
Facsimile: (215) 568-3439